



REMARKS

This application was filed on July 9, 1999 with a Petition to Make Special, and a Decision Granting the Petition to Make Special was mailed to Applicant on March 28, 2001. In light of the long pendency occasioned, Applicant has decided to file a continuation application in which certain claims will be further prosecuted, and to amend herein others of the pending claims (primarily objected to claims) to obtain allowance and patent issuance at the earliest opportunity. Therefore, Applicant has deleted without prejudice claims 1, 14, 26, 30, 33, 34 and 36-45 (as indicated hereabove), to pursue the invention described therein in a continuation application which will be filed shortly. Applicant has amended the claims as set forth hereabove and described herebelow in the belief that the amended and remaining claims are now in condition for allowance. Applicant's remarks related thereto are next presented.

In paragraphs 1 and 2 of the Office Action the Abstract is objected to. Responsive thereto, a replacement Abstract on a clean page is submitted herewith.

In paragraph 3 of the Office Action it is indicated that all prior objections to the claims in the First Office Action were satisfied by Applicant's first response. Applicant appreciates this indication.

In paragraph 4 of the Office Action it is indicated that Applicant misnumbered claims 49 and 50 submitted with Applicant's First Amendment. Applicant notes that the claims have been renumbered 48 and 49, and Applicant regrets its misnumbering.

In paragraph 5 of the Office Action claims 30, 33 and 49 (renumbered) are objected to, stating:

"In claim 30 at line 4, delete "said" and insert therefor --the--. Repeat the correction for claim 30 at line 6 (second occurrence) and claim 33 at line 2 (second occurrence).

In claim 49 at line 2, immediately following "said" and prior to "two" insert --at least--"

While Applicant has deleted independent claim 30 and dependent claim 33 in favor of a continuation application, Applicant has included the language of independent claim 30 into

previously dependent claims 31, 32 and 35. Applicant has made the requested language corrections regarding claim 30 into amended claims 31, 32 and 35.

With regard to claim 49, Applicant has amended claim 49 accordingly.

In paragraphs 6 and 7 of the Office Action claims 48 and 49 (renumbered) are rejected under 35 U.S.C. 112 first paragraph, stating:

“Claims 48 and 49 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the specification as originally filed does not provide support for the cable pulling device having a first frame portion moveable engaged with a second frame portion.”

Applicant respectfully traverses this ground of rejection and asserts that the specification as originally filed (as well as the parent PCT application and the original provisional application) includes support for these claim limitations. Specifically, claims 48 and 49 are directed to Applicant's cable pulling device, such as is depicted in Figs. 9 and 28 of the Application.

With specific reference to the specification, page 11, lines 1-18 (describing the cable pulling device depicted in Fig. 9), and page 19, line 20 through page 20, line 21 (describing the cable pulling device depicted in Fig. 28), it is described that each cable pulling device includes two frame portions, specifically the forward end fixture 528, and the front end block 536 (see Fig. 9) and 1412 (see Fig. 28). It is further described that the forward end fixture 528 and the front end lock (536 or 1412) are movably engaged with each other through the piston rods 524. Applicant therefore respectfully submits that the Specification does provide support for the cable pulling device having a first frame portion movably engaged with a second frame portion, and that this ground of rejection has been satisfied.

In paragraph 8 of the Office Action it is indicated that all prior rejections of the claims under 35 U.S.C. 112 second paragraph were overcome by Applicant's First Amendment. Applicant appreciates this indication.

In paragraphs 9 and 10 it is indicated that claims 30 and 33 are rejected under 35 U.S.C. § 102(e) as being anticipated by Lincoln, U.S. Patent No. 6,109,832. Responsive thereto, Applicant has deleted claims 30 and 33 from this Application without prejudice to further

prosecute claims 30 and 33 in a continuation application to be filed shortly. Applicant will traverse this ground of rejection in the continuation application, thus Applicant's deletion of claims 30 and 33 without prejudice is not for patentability reasons, but rather to obtain early issuance of other claims of this application, and is not to be taken as an acquiescence to this rejection.

In paragraphs 11 and 12 of the Office Action claim 1 is rejected under 35 U.S.C. § 103 as being unpatentable over Fisk, in view of Poweram Model 7000. Responsive thereto, Applicant has deleted claim 1 from this application without prejudice, and will further prosecute claim 1 in a continuation application to be filed shortly. Applicant will traverse this ground of rejection in the continuation application in that the Poweram Model 7000 reference (CC) is a rod pusher/puller and not a cable pulling device. As such, the Poweram Model 7000 is generally cumulative to the rod puller/pusher device depicted and described in Fisk. Applicant's deletion of claim 1 from this application is not for patentability reasons, but rather to obtain early issuance of other claims of this application, and is not to be taken as an acquiescence to this rejection.

In paragraph 13 of the Office Action claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fisk et al. Responsive thereto, Applicant has deleted claim 14 from this application without prejudice, and will further prosecute claim 14 in a continuation application to be filed shortly. Applicant will traverse this ground of rejection in the continuation application in that the Fisk reference does not teach nor suggest the use of an annulus member, nor does it teach the formation of a cable insertion slot through such an annulus member. Applicant's deletion of claim 14 from this application is not for patentability reasons, but rather to obtain early allowance of other claims of this application, and is not to be taken as an acquiescence to this rejection.

In paragraph 14 of the Office Action claims 16, 17, 26 and 36-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisk in view of Vermeer. Regarding claim 16, it is dependent from claim 14 and claim 17 is dependent from claim 16, and Applicant reserves the right to include the limitations of claims 16 and 17, in their dependence from claim 14 in the continuation application to be filed shortly. However, for the purpose of this pending

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application, Applicant has amended claim 16 to be dependent from objected to claim 15 which has been made independent, as is discussed in detail herebelow.

With regard to claim 26, Applicant has deleted claim 26 from this application without prejudice, and will further prosecute claim 26 in a continuation application to be filed shortly. Applicant will traverse this ground of rejection in the continuation application. Applicant's deletion of claim 26 from this application is not for patentability reasons, but rather to obtain early allowance of other claims in this application, and is not to be taken as an acquiescence to this rejection.

Responsive to this paragraph 14, Applicant has deleted claims 36-39 from this application without prejudice, and will further prosecute claims 36-39 in a continuation application to be filed shortly. Applicant will traverse this ground of rejection in the continuation application in that the annulus member described in independent claim 36 is not taught by Fisk nor Vermeer, nor is the cable insertion slot formed through portions of the annulus member taught therein. Applicant's deletion of claims 36-39 from this application is not for patentability reasons, but rather to obtain early allowance of other claims of this application, and is not to be taken as an acquiescence to this rejection.

Responsive to this paragraph 14, Applicant has deleted claims 40-45 from this application without prejudice, and will further prosecute claims 40-45 in a continuation application to be filed shortly. Applicant will traverse this ground of rejection in the continuation application, and Applicant's deletion of claims 40-45 from this application is not for patentability reasons, but rather to obtain early allowance of other claims of this application, and is not to be taken as an acquiescence to this rejection.

In paragraph 15 of the Office Action claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lincoln 6,109,832. Applicant notes that claim 34 is dependent from claim 33 which is dependent from independent claim 30. Responsive thereto, Applicant has deleted claim 34 from this application without prejudice, and will further prosecute claim 34 in a continuation application to be filed shortly. Applicant will traverse this ground of rejection in the continuation application, and Applicant's deletion of claim 34 from this application is not for patentability reasons, but rather to obtain early allowance of other claims of this application, and is not to be taken as an acquiescence to this rejection.

In paragraph 16 of the Office Action claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fisk, in view of Vermeer, and further in view of Poweram Model 7000. Applicant notes that original claim 47 depends from independent claim 40 which has been deleted from this application, without prejudice, for future prosecution in a continuation application, as is described hereabove. Applicant reserves the right to prosecute the limitations of original claim 47 in the continuation application, and Applicant will traverse the grounds of this rejection in the continuation application in that the Vermeer prior art reference is not a cable pulling device, and the Poweram Model 7000 reference is also not a cable pulling device.

With further reference to claim 47 and this ground of rejection, Applicant has amended claim 47 in this application to be dependent from independent (as amended herein) claim 46, the allowability of which is discussed in greater detail herebelow.

In paragraph 17 of the Office Action allowable subject matter is indicated, stating:

“17. Claims 2, 6, 7, 11 through 13, 15, 18 through 25, 27 through 29, 31, 32, 35, and 46 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.”

Responsive thereto, Applicant appreciates the indication of allowable subject matter, and Applicant has amended various of the indicated claims as is set forth herein. Significantly, in making some of these claim amendments, Applicant has not included all of the limitations of the base claims, in that Applicant believes that some of the base claim limitations are unnecessarily restrictive and unnecessary to patentability. Each of the amended claims is next discussed as well as the pending claims.

Claim 2 -- Prior to this Amendment, objected to claim 2 was dependent from independent claim 1, and claim 1 included the limitation:

“and wherein said cable pulling device is a post tensioning ram (PTR).”

Applicant has amended claim 2 to include most of the limitations of prior independent claim 1. However, Applicant has deleted the overly restrictive limitation quoted above in the enclosed amendment to claim 2, and Applicant believes that amended claim 2 is patentable over the cited prior art.

Objected to claims 6 and 7 have not been amended herein. Claim 6 remains dependent from claim 2 and claim 7 is dependent from claim 6.

Regarding objected to claim 11: Prior to this Amendment, claim 11 was dependent from independent claim 1, and claim 1 included the limitation:

“and wherein said cable pulling device is a post tensioning ram (PTR).”

Applicant has amended claim 11 to include most of the limitations of prior independent claim 1. However, Applicant has deleted the limitation quoted above in the enclosed amendment to claim 11, and Applicant believes that amended claim 11 is patentable over the cited prior art.

Regarding objected to claims 12 and 13, claim 12 has been amended to be dependent from claim 2 (it was previously dependent from claim 7), and a further limitation (previously set forth in claim 1 from which claim 12 ultimately previously depended) that the cable pulling device is a post tensioning ram (PTR) has been added thereto. Claim 13 remains dependent from claim 12.

Regarding objected to claim 15, it was previously dependent from independent claim 14, and it has been amended to include all of the limitations of claim 14. However, Applicant has further amended claim 15 to delete the phrase “holding means for releasably holding a portion of said cable pulling device therewithin”, and inserted therefor --engagement portion for releasably engaging a portion of said cable pulling device.--. Applicant believes that the deleted phrase was unnecessarily restrictive, and Applicant has included the amendment accordingly. Applicant submits that claim 15 is allowable as amended herein.

Regarding objected to claims 16 and 17, Applicant has amended dependent claim 16 from its prior dependency upon claim 14 to be dependent from amended independent claim 15 described above. Claim 17 is unamended herein and remains dependent from claim 16. Applicant submits that claims 16 and 17 are therefore now in condition for allowance.

Regarding objected to claims 18 through 25, these claims are dependent from amended independent claim 15 and/or from intermediate claims that are dependent from claim 15, and Applicant submits that they remain allowable as indicated in paragraph 17 of the Office Action.

Regarding objected to claim 27, it previously depended from independent claim 26, and Applicant has included all of the limitations of claim 26 into claim 27, whereby amended independent claim 27 contains allowable subject matter as indicated in paragraph 17 of the Office Action.

Regarding objected to claims 28 and 29, they are unamended herein and remain dependent from claim 27 and it is indicated in paragraph 17 of the Office Action that claims 28 and 29 contain allowable subject matter.

Regarding objected to claims 31, 32 and 35, each was previously dependent from independent claim 30, and Applicant has included all of the limitations of claim 30 into these claims, and it is indicated in paragraph 17 of the Office Action that these claims 31, 32 and 35 contain allowable subject matter.

Regarding objected to claim 46, it was previously dependent from independent claim 40, and Applicant has amended claim 46 to be an independent claim by including most of the limitations of prior claim 40 into claim 46. Significantly, Applicant has omitted the limitation:

“after said cable is disposed through said pipe”

that was previously set forth in claim 40, from inclusion in the language of amended independent claim 46. Applicant submits that the omitted limitation is unnecessarily limiting and that claim 46 now recites patentable subject matter, although it does not contain that unnecessary limitation.

Regarding previously rejected claim 47, Applicant has amended it to be dependent from claim 46 which Applicant argues above to be an allowable independent claim.

Regarding independent claim 48, it has been rejected (as discussed hereabove) in reference to paragraph 7 of the Office Action, under 35 U.S.C. § 112. Based on Applicant's arguments related thereto, Applicant submits that independent claim 48 comprises allowable subject matter.

Regarding previously rejected claim 49, it is dependent from claim 48, and Applicant likewise submits that it comprises allowable subject matter.

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In paragraph 18 of the Office Action a statement of reasons for the indication of allowable subject matter is presented. The statement of reasons states:

“With respect to claims 2, 6, 7, 12, 13, and 15, modification of the Poweram Model 7000 device to include the collets is precluded in that the reference is silent with respect to the same and actually appears to teach away from the claimed subject matter with the disclosure of a “jaw system.”

With regard to collets in a post tensioning ram, reference is made to the post tensioning ram on page 3 of item CE of Applicant's Information Disclosure Statement, which, in the bottom third of page 3 depicts and describes a collet set for use in a PTR. As taught therein, the collet set is selectable for different diameter cables. With regard to Applicant's invention, and claims such as claim 2, it is significant that the PTR device depicted in reference CE includes only one set of collets.

The statement for reasons for the indication of allowable subject matter of claims 11, 25, 30 (sic 31), 32 and 35 states:

“With respect to claims 11 and 25, Fisk et al. '542 expressly teaches the use of a mole which spreads an existing pipeline as opposed to fracturing it in column 13 on lines 18 through 27. Therefore, the reference cannot be modified to include a mole as taught by Lincoln '832 over which claims 30 through 32 and 35 are deemed.”

Responsive thereto, Applicant notes that both Fisk and Lincoln teach a mole wherein outwardly projecting fins or blades make contact with the pipe to fracture it. In distinction thereto, and as set forth in the claims, Applicant's mole makes contact with the pipe and fractures the pipe using a smooth tapered surface. While Applicant's mole further includes a blade for the subsequent cutting of pipe joint structures, the pipe fracturing as conducted by Applicant's mole is performed with a smooth tapered surface, not taught by Fisk or Lincoln.

In paragraph 19 of the Office Action, Applicant is directed to comply with formal requirements regarding allowable subject matter or specifically traverse each requirement not complied with. Applicant believes it has complied therewith with regard to this Amendment.

In paragraph 20 of the Office Action Applicant's arguments filed January 9, 2001 are commented upon, stating:

“With respect to Applicants’ statements regarding the Poweram devices and no known use of the same to pull lengths of cable attached to bursting rams or moles through ground, the Examiner notes the express disclosure of the same for pipe rehabilitation applications in the Poweram Model 7000 brochure.”

Responsive thereto, Applicant notes that the Poweram 7000 device is a rod puller/pusher which operates in a significantly different manner from a cable pulling device. Specifically, the Poweram devices are not cable pulling devices, much less post tensioning ram type cable pulling devices as are depicted in reference CE of Applicant’s Information Disclosure Statement.

In paragraph 21 of the Office Action comment is made regarding Applicant’s arguments with respect to claims 1, 30, 33 and 34, as well as claims 14, 16, 17 and 36-39. Responsive thereto, Applicant has addressed these arguments and provided further arguments and/or amendments to claims as set forth hereabove. Additionally, regarding specific claims, as set forth and discussed in detail hereabove, applicant has deleted certain claims from this Application without prejudice and will file such claims in a continuation application to be filed shortly. As described hereabove in detail, Applicant’s deletion of such claims has not been made for reasons of patentability, but rather in order to obtain early allowance and issuance of a patent that includes many allowable claims. Applicant will address such claims, arguments and prior art in said continuation application.

Lastly, in reviewing the application, Applicant has noted small discrepancies between Fig. 9 and the description of Fig. 9 in the specification. Related thereto, Applicant has amended Fig. 9, as shown in red in the copy of Fig. 9 submitted herewith, to add numbers 512, 514 and 516 at the appropriate location. No new matter is added to the application through this amendment.

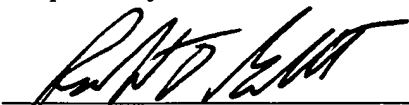
Having responded to all of the paragraphs of the Office Action, and having amended the claims accordingly, Applicant respectfully submits that the claims, as amended, are now in condition for allowance. Applicant therefore respectfully requests that a Notice of Allowability be forthcoming at the Examiner’s earliest opportunity. Should the Examiner have any questions

or comments with regard to this Amendment, a telephonic conference at the number set forth below is respectfully requested.

Dated: May 3, 2001

OPPENHEIMER WOLFF & DONNELLY LLP
Customer No. 25696
1400 Page Mill Road
Palo Alto, CA 94304
Tel: (650) 320-4000
Fax: (650) 320-4100

Respectfully submitted,



ROBERT O. GUILLOT
Reg. No. 28,852

I hereby certify that this correspondence with all attachments is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Box Amendment, Commissioner for Patents, Washington, D.C. 20231 on May 3, 2001 by Patricia Beilmann.